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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,753	03/16/2004	Lorenz Berchtold	21334-1311	3426

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/801,753

Applicant(s)

BERCHTOLD ET AL.

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Response to Election

1. This action is in response to the provisional election mailed August 15, 2006. (Group I) Claims 1-14 was elected rendering (Group II) Claims 15-21 as a withdrawn invention, which has been cancelled by Applicant. Applicant added new claims 22-26, rendering claims 1-14 and 22-26 pending.

Claim Rejections – 35 USC § 102(b)

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 6-9, 13-14, 22-23 and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Pfaffelhuber et al (U.S. 6,202,786).

Pfaffelhuber discloses a constructional unit (column 3, lines 31-32) comprising a metal covering layer (5) (column 2, lines 19-21) along with a supporting body (1) (frame) having spacers (2) protruding up between the supporting body and the covering layer (column 3, lines 31-35 and Figures 1-3). The covering layer comprises a hot melt adhesive on the underside which contacts the spacers (column 3, line 67 through

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column 4, line 2 and Figure 3). The supporting body (frame) consists of polypropylene material, which Pfaffelhuber teaches is a thermoplastic material (column 2, line 14).

Because Pfaffelhuber discloses a constructional unit having a frame formed of a different material (thermoplastic) than the cover (metal), it is inherent for the cover to have a different coefficient of thermal expansion than the frame. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art.

Claim Rejections – 35 USC § 103(a)

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-5 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pfaffelhuber et al (U.S. 6,202,786) in view of Sprauer (U.S. 3,637,551).

Pfaffelhuber is relied upon for claim 1. Pfaffelhuber does not explicitly disclose the adhesive is two component, cross-linking or polyamide. Sprauer teaches hot melt crosslinked polyamides formulated with other ingredients are useful as adhesives in

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joining various materials, such as plastics and metals, together (column 1, lines 61-64 and column 4, lines 58-68). It would have been obvious to one of ordinary skill in the art to have incorporated the hot melt crosslinked polyamide adhesive of Sprauer in place of the hot melt adhesive of Pfaffelhuber to improve the peel strength of the adhesive material in the constructional unit, which will improve the strength of the adhesive bond (column 1, lines 61-65 and column 4, lines 69-75).

Claim Rejections – 35 USC § 103(a)

6. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pfaffelhuber et al (U.S. 6,202,786) in view of Applicant's own admission.

Pfaffelhuber is relied upon for instant claim 1 as above. Pfaffelhuber does not disclose the constructional unit comprising electronic components thermally coupled to the metal cover. In paragraph two, of the section labeled, Background of the Invention, of the instant specification, Applicant admits it is known for metal plates (cover) to be thermally coupled to electronic components in constructional units. It would have been obvious to one of ordinary skill in the art for an electronic component to be thermally coupled to the metal cover of Pfaffelhuber because Applicant admits this is a conventional practice within the art.

Response to Arguments

7. Restriction requirement made on May 16, 2006, is withdrawn due to Applicant canceling claims 15-21.

Applicant's remarks to rejection made under 35 U.S.C. 102(b) as being anticipated by Patil (U.S. 3,995,613) are moot based on grounds of new rejection.

Applicant's remarks to rejection made under 35 U.S.C. 103(a) as being unpatentable over Tyler et al. (U.S. 5,399,805) in view of Nicholson (U.S. 4,337,709) are moot based on grounds of new rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson
Patent Examiner
AU 1774



RENA DYE
SUPERVISORY PATENT EXAMINER

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12/2/04